

REMARKS

This application has been carefully reviewed in light of comments made by the Examiner in her Advisory Action dated April 5, 2007. In view of these comments, a Request for Continued Examination (RCE) is being filed concurrently herewith, so as to re-open prosecution on the merits and to afford additional opportunity to explain non-obviousness of the present invention.

As part of the Request for Continued Examination, a Preliminary Amendment is being made to all claims herein, so as to emphasize that a scanner node receives a scan order through a computer network. Thus, the invention involves more than transmission of a scanned image across a network; the invention further involves receipt of a scan order, and the scan order itself is received through the computer network.

Applicant respectfully reasserts his traversal of the rejection of the claims herein, on the grounds of his continued belief that the requirements for a *prima facie* case of obviousness have not been established. Points made in the Response dated February 5, 2007 are expressly incorporated herein by reference. Essentially, Applicant respectfully maintains that there is no teaching or suggestion, in the art of record, to modify the teachings of Lo with the teachings of Cunningham or Owa, with a reasonable expectation of success.

In her Advisory Action of April 5, 2007, the Examiner provided additional justification for making these modifications. According to the Advisory Action, columns 1 and 2 of Lo specify an objective to provide a scanning system capable of retrieving and

transferring a scanned image over a computer network, and these two columns of Lo are cited as justification for modifying Lo with the teachings of Cunningham. Likewise, paragraph [0008] through [0010] of Owa specify an objective to provide a system that allows for the selection of an optimum printing device from among plural network printers for each printing job, and these paragraphs are cited as justification for modifying the teachings of Lo, as modified by Cunningham, with the additional teachings of Owa.

Applicant respectfully disagrees that the cited portions of either Lo or Owa provide any justification at all, for modifying the teachings of Cunningham. The Applicant's disagreement is primarily on two grounds: that the cited portions provide only generalized objectives without also providing specific suggestions of the means by which those objectives might be obtained; and that even to the extent that these generalized objectives are meaningful, the cited references themselves also state specifically that the objectives have already been met without the need for any additional modifications. These two points are explained in detail hereinbelow.

First, the cited portions of Lo and Owa merely specify disadvantages of then-current art, and then articulate a generalized objective to overcome them. For example, the cited portions of Owa include the following object:

“[I]t is an object of this invention to provide a network scanning system which allows the transfer of image information from a scanner to a client computer over a computer network.” (Column 2, lines 2-6).

Such a statement is only a generalized objective, without also providing some suggestion as to the means by which such an objective might be accomplished. Put another way, the

rejection “reads too much” into insufficient guidance provided by Owa’s objectives.

Reliance on the cited portions of Lo and Owa is therefore nothing more than improper hindsight analysis, and reflects a reading into the art of the Applicant’s own teachings.

As to the second point, when taken in their full context, the cited portions of Lo and Owa are more correctly viewed as an articulation of objectives that are thereafter satisfied by the arrangements described by Lo and Owa themselves. For example, at column 2 of Lo, after stating his objectives, Lo goes on to state that these objectives are “accomplished”. Column 2, line 22. Thus, when read in their full context, the cited portions of Lo are more correctly seen to state that there is nothing further to do: that the objectives listed by Lo are “accomplished” by the arrangement described by Lo himself. Thus, when an ordinarily-skilled artisan reads the cited sections of Lo, he would be led to the inevitable conclusion that no further modifications are desirable, since these objectives have all been “accomplished”.


Likewise, paragraph [0010] of Owa specifies that the objectives listed by Owa are “provided” by his own invention. Accordingly, and similar to the circumstances of Lo, an ordinarily-skilled artisan would understand that Owa leaves no further room for modifications, since all of his objectives have been “provided”.

The filing of this RCE, and the corresponding re-opening of prosecution, provides the Examiner with a fresh opportunity for a critical review of the current obviousness rejection, to determine whether it meets the factual predicates needed to establish *prima facie* obviousness. It is respectfully submitted that when the claimed

invention is viewed as a whole, and that when the invention and the cited art are viewed through the eyes of a person having ordinary skill in the art at the time of the invention, that it cannot be properly concluded that the invention would have been obvious.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael K. O'Neill", written over a horizontal line.

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